

The opinion in support of the decision being entered today is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TODD R. WILLIAMS and
OLESTER BENSON, JR

Appeal 2007-1389
Application 10/790,898
Technology Center 1700

Decided: July 27, 2007

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and LINDA M.
GAUDETTE, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
decision rejecting claims 1-26. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. BACKGROUND

The invention relates to a composite article including a layer of radiation cured polymer on a metal foil backing. The exposed surface of the radiation cured layer has a three-dimensional microstructure. The composite article has large scale dimensional stability. Claim 1 is illustrative of the subject matter on appeal:

1. A composite article having large scale predictable dimensional stability comprising:
 - a. a metal foil backing having a back surface and an opposite front surface; and
 - b. a layer of a radiation cured polymer having an exposed front surface bearing a three-dimensional microstructure of precisely shaped and located functional discontinuities including distal surface portions and adjacent depressed surface portions and an opposite surface in adherent contact with the front surface of said backing.

The Examiner relies on the following prior art reference to show unpatentability:

Lu	US 5,468,540	Nov. 21, 1995
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The rejections as presented by the Examiner are as follows:

1. Claims 1-11 and 13-22 are rejected under 35 U.S.C. § 102(b) as anticipated by Lu; and
2. Claims 12 and 23-26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lu.

In reviewing the rejections, we consider the dispositive issues arising from the contentions in the Brief filed August 31, 2006, the Answer filed October 5, 2006, and the Reply Brief filed December 5, 2006.

II. DISCUSSION

A. Issue

The dispositive issue arising from the contentions of the Examiner and Appellants is whether Lu describes a composite article having “large scale predictable dimensional stability” as claimed (see Claims 1 and 11).

B. Facts

1. The clause “large scale predictable dimensional stability” is recited in the preamble of claims 1 and 11, the independent claims.
2. The clause “large scale predictable dimensional stability” is defined in the Specification as referring to “the ability of a segment of shaped sheet-like substrate to retain substantially its predicted dimensions after being subjected to a heated environment of 150°C or less for 60 minutes or less and then returned to ambient temperature.” (Specification 8:1-4).
3. The “predicted dimensions” are dimensions resulting from known or predictable shrinkage or expansion that takes place during curing of the radiation curable composition (Specification 12:24 to 13:17). The term “predictable” dimensional stability is intended to take into account such shrinkage or expansion because the master used to impart the microstructure on the surface of the curable layer is easily made oversized to produce predictable dimensions in the cast polymer after curing (Specification 13:7-15).

4. The Specification does not particularly limit the identity of the curable composition beyond disclosing that it must be capable of being radiation cured (Specification 12:12-23).
5. The “large scale dimensional stability” of the composite article is a property of the article.
6. Lu describes a composite article (base sheet 11 as shown in Figure 1) including an array 14 and a reflective layer 17 (Lu, col. 3, ll. 59-64).
7. Array 14 is formed from a radiation curable oligomeric composition (Lu, col. 2, l. 64 to col. 3, l. 12 (curable composition spread between a substrate film and the master); col. 8, ll. 35-48)). The compositions suggested as useful are the same or similar to those disclosed in Appellants’ Specification and include, for instance, urethane-based oligomers and acrylates (Compare Lu, col. 8, ll. 45-46 and col. 9, ll. 12-18 with Specification 12:17-23).
8. Lu does not expressly state that the composite has “large scale predictable dimensional stability.”

C. Principles of Law

“[A] prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency.” *In re Omeprazole Patent Litigation*, 483 F.3d 1364, 1373, 82 USPQ2d 1643, 1650 (Fed. Cir. 2007). When a claimed product appears to be substantially identical to a product disclosed by the prior art, the burden is on the Applicants to prove that the product of the prior art does not necessarily or inherently possess characteristics or properties attributed to the claimed product. *In re Spada*,

911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

D. Analysis

As a first matter, we agree with Appellants that all the claims are limited to composite articles having “large scale predictable dimensional stability” as that phrase further limits a property of the article, i.e., gives life and meaning to the claim, rather than merely defining an intended use or an inherent property of the structure recited in the body of the claim. *See Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951) (A preamble reciting “An abrasive article” was deemed essential to point out the invention defined by claims to an article comprising abrasive grains because “abrasive” further limited the structure of the article).

As a second matter, we agree with Appellants that “large scale predictable dimensional stability” has been given a special meaning in the Specification and that meaning governs when interpreting the claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-16, 675 USPQ2d 1321, 1329 (Fed. Cir. 2005) (“[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs.”). As claimed, the composite article must have at least a segment that retains substantially its predicted dimensions after heating as required by Appellants’ definition (FF 2; see also FF 3).

Lu discloses a composite article (FF 6). However, while Lu does not expressly disclose that the claimed property is present in Lu’s described composite article, the Examiner points out that the radiation curable composition of Lu is a curable oligomeric composition, the same type of

composition disclosed as useful by Appellants. Appellants argue that the Examiner has not supported a finding that “such a broad class of materials all have this property,” i.e., the claimed stability property (Reply Br. 4). But nor does the Specification provide any evidence that the broad class does not have the claimed property. Appellants’ Specification, in fact, does not particularly limit the identity of the radiation curable composition (FF 4) and the radiation curable compositions disclosed by Lu are the same or similar to those exemplified in the Specification (FF 7). Therefore, there is a reasonable basis to conclude the claimed property is inherently present in Lu’s composite such that the burden is shifted to Appellants to show that the property is, in fact, not present. *Spada*, 911 F.2d at 708, 15 USPQ2d at 1657; *Best*, 562 F.2d at 1255, 195 USPQ at 433. Appellants provide no objective evidence showing, in fact, the composite of Lu does not have the claimed property.

III. CONCLUSION

We conclude that the Examiner reasonably supported the finding that Lu describes a composite article having “large scale predictable dimensional stability” as claimed. Therefore, we find a preponderance of the evidence supports the Examiner’s finding of anticipation.

With respect to the rejection of dependent claims 12 and 23-26 under 35 U.S.C. § 103(a) as unpatentable over Lu, Appellants advance no additional arguments. Therefore, we sustain the rejection of 12 and 23-26 for the reasons presented above.

IV. DECISION

The decision of the Examiner rejecting claims 1-11 and 13-22 under 35 U.S.C. § 102(b) and claims 12 and 23-26 under 35 U.S.C. § 103(a) is affirmed.

V. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

TLC/lc/cam

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